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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,740	04/18/2000	Anthony Murray	5697.200-US	2226

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EXAMINER

ROBINSON, BINTA M

ART UNIT PAPER NUMBER

1625

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicant(s)

09/551,740

MURRAY ET AL.

Examiner

Binta M. Robinson

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,25-28,31,32,38-42 and 51-54 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,25-28,31,32,38-42 and 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### Detailed Action

The 112, second paragraph rejection of claims 1, 3-4, 25-28, 31-32, 38-42, 51-54 is withdrawn in light of applicant's amendment at paper no. 19.

#### (modified rejection)

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-4, 25-28, 31-32, 38-42, 51-54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for A1, A2 equal to saturated, unsaturated or aromatic 5-6 membered cyclic ring systems equal to thienyl and pyridinyl. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The scope of the claims fails to meet the requirements of enablement and directional guidance. There is no reasonable showing that such diverse compounds will have all of the alleged properties.

The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. The applicant is referred to *In re Douche* 169 USPQ 429 coca, 1971, MPEP 716.02 B. The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the

incorporation of the 8 factors recited in *Ex parte Foreman* 230 USPQ 546 (Bd. Of App. And Inter 1986).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art 6) the amount of direction provided by the inventor 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In *re Wands*, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In terms of the first Wands factor of breadth, A1 and A2 encompass an array of Markush grouping of moieties other than the phenyl and furyl rings, exemplified. In terms of the nature of the invention which is the second Wands factor, these compounds are useful in treating conditions mediated by the peroxisome proliferator-activated receptors. In terms of the fifth Wands factor, the level of predictability in the art is low, because there are no examples of these compounds effect on nuclear receptor activity. In terms of the sixth Wands factor, the amount of direction provided by the inventor is poor, because the applicant does not show test results for these compounds effect on nuclear receptor activity. In terms of the 8<sup>th</sup> Wands factors, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the

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invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

**Response to Applicant's Remarks**

The applicant traverses the 112, first paragraph rejection of moieties A1 and A2 alleging that the amendment of these terms overcomes the rejection. However, there is no reasonable assurance that the different heterocyclic ring systems, particularly those such as thienyl and pyridinyl not exemplified would have the alleged utilities. See in re Fouché, 169 USPQ 429 (CCPA 1971) There is not sufficient exemplification to show That all of the ring systems could be obtained synthetically.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.